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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,593	07/08/2003	Joern Mika	058058-5001	8284

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Daniel H. Golub  
1701 Market Street  
Philadelphia, PA 19103

EXAMINER

HAILU, TADESSE

ART UNIT PAPER NUMBER

2173

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/615,593	<b>Applicant(s)</b> MIKA, JOERN	
	<b>Examiner</b> Tadesse Hailu	<b>Art Unit</b> 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-7 is/are allowed.
- 6) ☒ Claim(s) 1,2,8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This Office Action is in response to the above patent application number filed on July, 8, 2003
2. The Information Disclosure Statements with references submitted on August 31, 2006 are considered and entered.
3. The pending claims 1 through 9 are examined herein as follows.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Gardner et al (7003734).

Gardner relates to the field of creating and displaying images over a large computer network, and in particular, creating and displaying images including pop-up images.

With regard to claim 1:

Gardner discloses a method of selectively delivering advertising message/content to a person. The method steps used for delivering advertising content to a person are similar as the current invention.

As per “(a) downloading, at a user display station, a file with code for displaying an electronic page containing an embedded content-tag, wherein the page contains space for displaying selected content;” (see column 3, lines 33-67, column 9, lines 26-59; column 8, lines 3-17).

As per “(b) in response to receipt of the embedded content-tag at the user display station, issuing a first request to a content delivery network for information associated with the embedded content-tag and processing code;” (see column 9, lines 26-59)

As per “(c) in response to receipt by the content delivery network of the first request, downloading the information associated with the embedded content-tag and the processing code from the content delivery network to the user display station, wherein the information associated with the embedded content-tag includes information about a plurality of active content campaigns associated with the embedded content-tag and targeting criteria;” (column 4, lines 1-20, column 11, lines 31-42). and

As per “(d) selecting, at the user display station, one of the plurality of active content campaigns using the processing code and in accordance with the information

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about the active content campaigns and the targeting criteria." (column 11, lines 61-column 12, lines 3, column 10, lines 14-26).

With regard to claim 2:

As per "(e) issuing a second request from the user display station to the content delivery network for advertisement information associated with the selected campaign;" (see column 9, lines 26-39).

As per "(f) in response to receipt of the second request, downloading the advertisement information to the user display station;" (see column 3, lines 33-67).

As per "(g) selecting, at the user display station, an advertisement from the downloaded advertisement information using the processing code and in accordance with the targeting criteria;" (column 9, lines 26-47, Figs. 2 and 3) and

As per "(h) displaying, at the user display station, the selected advertisement in the space on the page (see Gardner's claim 1).

With regard to claim 8:

Independent claim 8 corresponds generally to independent claim 1 and recites similar features in System form, and therefore is rejected under the same rationale.

With regard to claim 9:

Independent claim 9 corresponds generally to independent claim 2 and recites similar features in System form, and therefore is rejected under the same rationale.

5. Claims 1-2, and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Marks et al (WO 00/41112).

Marks is related to advertising using networked devices. More particularly, Marks relates to a dynamic micro-targeted advertising to users of networked devices. Marks discloses a script-based advertisement. Similar to the current invention, Marks discloses a several method steps for selecting advertisement (see Fig. 8). Figure 8 is a flow diagram of an advertisement script running within a client application. First a client session is initiated at 800. As a result of the session, an advertisement script is dynamically generated . That is, advertising scripts are dynamically generated based on information related to the specific user of a specific networked device (e.g., terminal, workstation).

Then, downloading (e.g., from a server) the advertising script to the client terminal, that is the client application receives an advertisements script for the session at 805. The script comprises a code and advertisement data file(e.g., color, duration and other information in the advertisement script).

Then, in response to receiving the advertisement script, the client application executes the script at 810 by displaying advertisements according to the placement, color, duration and other information in the advertisement script.

Then, the advertisement sleeted is determined based on input and output trigger/modification events. for example, if a user selects a remote resource (e.g., web page ) associated with an advertisement in the script, the scripts ordering may be

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modified (see the method steps in Fig. 8, Also see the method steps in Marks's claim 1).

With regard to claim 2:

Marks also describes the limitation of claim 2 by way of the method steps of Figs. 5 and 8. Fig. 5 is a flow diagram for generating a micro-targeted advertising script. Figure 8 is a flow diagram of an advertisement script running within a client application.

Mark also describes issuing a second request from the user display station to the content delivery network for advertisement information associated with the selected campaign (page 13, page 19).

Marks also discloses that in response to receipt of the second request, downloading the advertisement information to the user display station (page 13, page 19);

Marks also discloses selecting, at the user display station, an advertisement from the downloaded advertisement information using the processing code and in accordance with the targeting criteria (e.g., user profile) (page 12) ; and

Mark describes that one or more advertisements are displayed to the user (at step 530) using the display layout of Fig. 6 (also see page 14).

With regard to claim 8:

Independent claim 8 corresponds generally to independent claim 1 and recites similar features in System form, and therefore is rejected under the same rationale.

With regard to claim 9:

Independent claim 9 corresponds generally to independent claim 2 and recites similar features in System form, and therefore is rejected under the same rationale.

6. Claims 1-2, and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Dorfman (WO 01/11504).

Dorfman discloses a systems and methods for displaying advertisements when web pages are viewed. As illustrated in Fig. 3, Dorfman describes the method steps of claim 1. Dorfman describes downloading, at a user display station, a file with code for displaying an electronic page containing an embedded content-tag, wherein the page contains space for displaying selected content (page 2, summary section, page 4, see the method steps description of Fig. 3);

Dorfman also describes that in response to receipt of the embedded content-tag at the user display station, issuing a first request to a content delivery network for information associated with the embedded content-tag and processing code (page 2, summary section, page 4, see the method steps description of Fig. 3);

Dorfman also describes that in response to receipt by the content delivery network of the first request, downloading the information associated with the embedded content-tag and the processing code from the content delivery network to the user display station, wherein the information associated with the embedded content-tag includes information about a plurality of active content campaigns associated with the embedded content-tag and targeting criteria (page 4, see the method steps of Fig. 3 and see Dorfman's claim 1).

and



Dorfman also describes that selecting, at the user display station, one of the plurality of active content campaigns using the processing code and in accordance with the information about the active content campaigns and the targeting criteria (Figs. 2, 4A and 4B, pages 3 and 4, see the method steps of Fig. 3).

With regard to claim 2:

Dorfman also describes that issuing a second request from the user display station to the content delivery network for advertisement information associated with the selected campaign (page 2 and page 4, see the method steps of Fig. 3).

Dorfman also describes that in response to receipt of the second request, downloading the advertisement information to the user display station (page 4, see the method steps of Fig. 3).

Dorfman also describes selecting, at the user display station, an advertisement from the downloaded advertisement information using the processing code and in accordance with the targeting criteria (see Figs. 2m 4A and 4B, page 3); and

Dorfman also describes that displaying, at the user display station, the selected advertisement in the space on the page (see Figs. 2m 4A and 4B, page 3, also see Dorfman's claim 1).

With regard to claim 8:

Independent claim 8 corresponds generally to independent claim 1 and recites similar features in System form, and therefore is rejected under the same rationale.

With regard to claim 9:

Independent claim 9 corresponds generally to independent claim 2 and recites similar features in System form, and therefore is rejected under the same rationale.

7. Claims 1-2, and 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al (2004/0093327).

Anderson discloses a method for serving advertisement based on content. In one embodiment the method steps are illustrated in Figs. 12 and 13. Anderson describes downloading, at a user display station, a file with code for displaying an electronic page containing an embedded content-tag, wherein the page contains space for displaying selected content (see section 4.1.1. *Exemplary advertising environment*, page 2, also see section 4.3 *Examples of operations*, page 13).

Anderson also describes in response to receipt of the embedded content-tag at the user display station, issuing a first request to a content delivery network for information associated with the embedded content-tag and processing code (see section 4.1.1. *Exemplary advertising environment*, page 2, also see section 4.3 *Examples of operations*, page 13).

Anderson also describes in response to receipt by the content delivery network of the first request, downloading the information associated with the embedded content-tag and the processing code from the content delivery network to the user display station, wherein the information associated with the embedded content-tag includes information about a plurality of active content campaigns associated with the embedded content-tag and targeting criteria (see section 4.1.1. *Exemplary advertising environment*, page 2, also sees section 4.3 *Examples of operations*, page 13).

Anderson also describes selecting, at the user display station, one of the plurality of active content campaigns using the processing code and in accordance with the information about the active content campaigns and the targeting criteria (see Figs. 9a-9c, see section 4.3 *Examples of operations*, page 13):

With regard to claim 2:

Anderson also describes issuing a second request from the user display station to the content delivery network for advertisement information associated with the selected campaign (see Figs. 9a-9c, see section 4.3 *Examples of operations*, page 13).

Anderson also describes in response to receipt of the second request, downloading the advertisement information to the user display station (see Figs. 9a-9c, see section 4.3 *Examples of operations*, page 13).

Anderson also describes selecting, at the user display station, an advertisement from the downloaded advertisement information using the processing code and in accordance with the targeting criteria (see Figs. 9a-9c, see section 4.3 *Examples of operations*, page 13).

Anderson also describes displaying, at the user display station, the selected advertisement in the space on the page (see e.g., Figs. 9a-9c).

With regard to claim 8:

Independent claim 8 corresponds generally to independent claim 1 and recites similar features in System form, and therefore is rejected under the same rationale.

With regard to claim 9:

Independent claim 9 corresponds generally to independent claim 2 and recites similar features in System form, and therefore is rejected under the same rationale.

*Allowable Subject Matter*

8. Claims 3-7 are allowed.

The following is an examiner's statement of reasons for allowance: The cited prior art fails to teach the claimed subject matter of the above claims as arranged in the claims.

9. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

*Conclusion*

10. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and Figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

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11. Information regarding the status of an application may be obtained from the patent application information retrieval (PAIR) system. Status information for published application may be obtained from either Private-PAIR or Public-PAIR. Status information for unpublished applications is available through Private-PAIR only. For more information about the PAIR system, please see [pair-direct.uspto.gov](http://pair-direct.uspto.gov) web site. Should you have questions regarding access to the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:30 – 7:00 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kincaid, Kristine, can be reached at (571) 272-4063 Art Unit 2173 and 2174.

*Examiner Tadesse Hailu*  
*Art Unit 2173 – Operator Interface*  
*10/27/06*

**TADESSE HAILU**

**Patent Examiner**

